

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	
Inventors: Christopher MARTIN	: Confirmation No. 3785
	:
U.S. Patent Application No. 10/783,031	: Group Art Unit: 2182
	:
Filed: February 23, 2004	: Examiner: Aurangzeb HASSAN
For: DATA STORAGE DRIVE AND METHOD EMPLOYING DATA COMPRESSION	

Attn: BOARD OF PATENT APPEALS AND INTERFERENCES

**APPELLANTS' REPLY BRIEF (37 C.F.R. 1.192)**

Mail Stop Appeal Brief  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellant submits this Reply Brief in response to the Examiner's Answer mailed April 21, 2008.

To the extent necessary, Appellant hereby requests any required extension of time under 37 C.F.R. §1.136 and hereby authorizes the Commissioner to charge any required fees not otherwise provided for to Deposit Account No. 08-2025.

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**I. Status of Claims**

No claims are allowed.

Appellant appreciates the indication that, after further review, the PTO has withdrawn the rejection based upon the prior art Aoki (US 6,069,763), admitting that the combination of Aoki in view of Appellant's Admitted Prior Art ("AAPA") does not render claims 22-27 and 29 as obvious under 35 U.S.C. §103(a).

Claims 22-27 and 29 stand rejected under 35 U.S.C. §103(a) as being obvious over a first Appellant's Admitted Prior Art ("AAPA4"), represented in Fig. 4, in combination with a second Appellant's Admitted Prior Art embodiment, represented in Figs. 2 and 3 ("AAPA23").

## **II. Grounds of Rejection to be Reviewed on Appeal**

A first Appellant's Admitted Prior Art ("AAPA4") represented in Fig. 4 in combination with a second Appellant's Admitted Prior Art embodiment represented in Figs. 2 and 3 ("AAPA23"), does not render obvious claims 22-27 and 29 under 35 U.S.C. §103(a).

### III. Arguments in Reply to the Examiner's Response to Argument

#### **The combination of AAPA4 in view of AAPA23 does not render claims 22-27 and 29 obvious**

Regarding independent claims 22, 25, 27, and 29, Appellant respectfully submits that Appellant's Figs. 2 and 3, ("AAPA23") and Appellant's Fig. 4 ("AAPA4") fail to present any apparent reason to combine references or modify prior art to create the Applicants' allegedly obvious claim elements.

First, the disclosures of AAPA4 and AAPA23, taken as a whole, do not suggest Appellant's claimed tape drive unit.

Second, the asserted combination of references does not teach or suggest all of Applicants' claim features.

Third, the grounds of rejection constitute an improper reconstruction of Appellant's claimed invention.

The Examiner admits that AAPA4 fails to explicitly disclose the monitoring and control elements claimed by Appellant and relies on AAPA23 to disclose "a control element configured to disable said data compression engine based upon a predetermined level of the data occupancy level of the buffer memory." Appellant respectfully submits that the combination of AAPA4 and AAPA23 is improper, and appears to be based on hindsight reasoning.

Page 3 of the specification details Fig. 2 and only discloses a prior art method of controlling tape speed by measuring buffer occupancy. Page 4 of the specification describes the plot of tape speed past a write head as depicted in Fig. 3. The specification only discloses wherein the amount of data in the buffer controls the tape speed. Notwithstanding the assertions of the Examiner, no compression of data stored by a buffer is disclosed or suggested. Indeed, nowhere does AAPA23 disclose, teach, or suggest a data compression engine.

Regarding AAPA4, although AAPA4 discloses data compression, the Appellant's specification, at page 5, line 25 – page 6, line 3, specifically states that compression is “only done on a once and for all basis at the start of a data storage session and the compression ratio is not changed during the entire back up....”

Appellant respectfully submits that neither AAPA23 nor AAPA4 suggests the desirability of combining such teachings. If the teachings of AAPA23 and AAPA4 could be combined, it would only be to allow the monitoring and control elements of AAPA23 to control the speed by which data exits the buffer AAPA4 and the speed of the tape drive. There is no basis for asserting that the monitoring and control elements of AAPA23 control the data compression engine 404 of AAPA4.

More specifically, Appellant respectfully submits that neither AAPA4 nor AAPA23 suggest the desirability of a feedback mechanism that monitors the level of compressed data in a buffer, and based upon a predetermined level of data in that buffer, disables the compression of data entering that buffer.

It is improper to use the claimed invention as an instruction manual to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The Office Action appears to use improper hindsight reconstruction to pick and choose among isolated disclosures. Therefore, it is respectfully submitted that the combination is improper. Accordingly, it is respectfully submitted that the Appellant's data compression engine is patentable over the combination of AAPA4 and AAPA23.

Based on each of the foregoing reasons, the rejection of independent claims 22, 25, 27, and 29 should be reversed.

Dependent claims 23, 24, and 26 depend variously from independent claims 22 and 25 and find support for the claimed limitations in a similar manner as set forth above. Accordingly, the rejection of claims 23, 24, and 26 should be reversed.

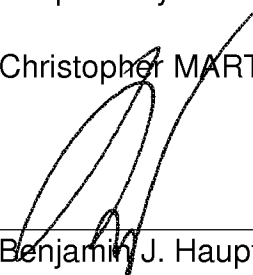
#### IV. Conclusion

Accordingly, Appellant respectfully submits that the rejection of claims 22-27 and 29 are in error, and request that the final rejection be reversed.

Respectfully submitted,

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